

Appl. No.: 10/015,780
Amendment dated October 13, 2004
Reply to Office Action of July 13, 2004

REMARKS/ARGUMENTS

The Office Action of July 13, 2004 has been reviewed and these remarks are responsive thereto. Claims 2-60 are pending in this application. By this amendment, claims 2, 34 and 45 have been amended. Claim 34 has been amended to correct a typographical error.

Claims 2-55 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,991,737 to Chen (Chen) in view of U.S. Patent No. 5,812,931 to Yuen (Yuen). Applicants respectfully traverse these rejections. Reconsideration and allowance of the instant application are respectfully requested.

Examiner Interview

Applicants thank the Examiner for courtesies extended to the undersigned during a personal interview on September 23, 2004. As discussed therein, the Examiner agreed to withdraw the finality of the Office Action as it improperly fails to address outstanding claims 56-60. Further, as discussed below, the Examiner agreed in principle that Chen fails to provide a motivation or suggestion to be combined with Yuen. In addition, it was agreed to in principle that the connection in Chen between the media facilitator 14 and the consumer receiver 16 is not associated with a consumer request for a connection (i.e., it's a one-way broadcast). Also, it was agreed to in principle that Chen does not disclose establishing a two-way connection between a consumer device and the media facilitator 14 (one-way broadcast) or between the consumer device and the media content originator 12 (via processing station 22).

Lack of Motivation To Combine References

Applicants respectfully submit that there is no motivation to combine the invention of Chen with that of Yuen. It is well grounded that the applied references must suggest or provide incentive to one of ordinary skill in the art that the modification of the primary reference should be carried out, and that such modification would have a reasonable likelihood of success. Applicants respectfully submit that the Examiner has not shown such an incentive when making the rejection. It is also well grounded that to form a basis for a proper rejection, both the incentive to make the

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proposed combination and the expectation of success of that combination must be founded in the prior art, not in the Applicants' disclosure.

The Examiner agreed in principle in the interview that Chen fails to provide a motivation to be combined with Yuen. As a basis for combining the references, the Office Action provides advantages that may be accomplished from the combination. However, these advantages are an end-result of a combination of Chen and Yuen, not a motivation or suggestion to combine the references in the first place. There is no reason that one of ordinary skill in the art would look to the invention of Yuen for modifying Chen.

In particular, the Office Action states that it would have been obvious to apply the teachings of Yuen to modify Chen's system "for the advantage of allowing the user to access new information via the established interactive link as well as eliminating a need for creating a RF link between the user and the broadcast center." Office Action, pages 3-4. It further states that such a modification would have been obvious "for the advantage of allowing the user to access new information via the established interactive link as well as enhancing the effectiveness of information exchange between the call server and the device associated with the broadcast program in order to allow the call server to provide the consumer the status (denial or acceptance) of the request or order." Office Action, pages 8-9. This is impermissible hindsight reconstruction. The cited advantages are an end-result of a combination of Chen and Yuen, not a motivation or suggestion to combine the references in the first place.

Further, Yuen was relied upon in the Office Action for its teachings of interactive communications and wireless connections. However, Chen already contemplates the use of interactive communications without any modifications. In particular, Chen discloses versions of the consumer transmitter that "can be, for example, multi-way broadband (cellular) or multi-way narrow-band PCS (paging), digital or analog, and alpha-numeric or voice-based." Chen, col. 5, lines 25-27. Thus, one of ordinary skill in the art would have no need to modify Chen further, because Chen's invention can apparently already make use of interactive communications and wireless communications.

In addition, it is entirely unclear how such a modification to Chen's system for ordering products or responding to broadcast information would be carried out, i.e., there is no

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expectation of success in the combination. Moreover, a combination of Chen with Yuen would not produce the claimed invention according to these claims.

Chen discloses a system and method for ordering products related to a broadcast radio or TV program through a process station. Chen teaches that a consumer 24 receiver receives non-interactive broadcast media from a media facilitator 14 (e.g., a radio station). As shown in Fig. 1 and discussed at col. 4, lines 9-29 of Chen, order data is sent from consumer 24 via consumer transmitter 18 to processing station 22. Processing station 22 can send feedback or an acknowledgment to consumer 24. However, Chen does not disclose or suggest any connection between the media facilitator 14 (e.g., "television stations, radio stations, and billboards," col. 3, lines 12-13) and the consumer 24 beyond non-interactive broadcast transmissions, nor does it disclose or suggest transmission of any requests for a connection between a consumer and the media facilitator.

Chen does not provide any indication that it would be desirable to provide two-way communication between the media facilitator and the consumer in addition to the disclosed ordering system. Further, it is unclear how such a combination could be accomplished, much less be obvious to one of ordinary skill in the art. At best, the combination would seemingly destroy or render superfluous the disclosed function of Chen's elaborate ordering system that relies on the processing station 22 as a central point to enable interactions between the consumer and the media facilitator.

Yuen discloses a two-way interactive television system based on pager technology. Yuen teaches sending a message from a pager transmitter (16) to an Information Provider (38) through a Network Operator Center (37) and vice versa. However, Yuen does not describe sending any requests to establish two-way communication or receiving a response containing connection information. Further, Yuen does not provide any indication that it would be desirable to implement a request system for establishing two-way communication between the information provider and the pager transmitter/receiver, and it is unclear how this would even be accomplished in the system of Yuen, either alone or in combination with Chen.

Moreover, a combination of Chen and Yuen as proposed would not result in the claimed invention. Presumably, such a hypothetical system would include the product ordering system of

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Chen that would include text messaging between the consumer transmitter/receiver and the processing station.

Accordingly, Applicants respectfully submit that the proposed combination Chen with Yuen is improper and that the rejection of claims 2-55 should be withdrawn on this basis.

Even If Combined, The Combination Does Not Disclose All Features Of Claims 2-55

Even assuming, *arguendo*, that Chen could properly be combined with Yuen, Applicants respectfully submit that the subject matter of the independent claims would not have been obvious, at least because the claimed features discussed below would not be disclosed or suggested by the proposed combination.

As agreed to in principle in the interview, Chen does not disclose establishing a two-way connection between a mobile device and a device associated with a broadcast program in response to a request for such a connection, nor does Yuen overcome this deficiency of Chen. As further agreed to in principle, the disclosed connection between the media facilitator 14 and the consumer 24 of Chen is a one-way, broadcast connection that is not associated with the consumer's request. Further, a two-way connection is not established between the media content originator 12 and the consumer in response to a request for such a connection.

Chen clearly does not disclose or suggest an interactive connection between a consumer device and media facilitator 14, much less establishing such a connection in response to a connection request. Chen states, "[a]ccording to the invention, there is an automated system for enabling consumers to respond to publicly broadcast information ... [that is] publicly broadcast over a non-interactive medium." Chen, col. 1, lines 30-32 and 38-39. The system of Chen "is made possible using existing media distribution channels, such as ordinary television, radio, and billboards, rather than specialized, interactive media distribution channels." *Id.* at 61-64. Further, the consumer receiver 16 of Chen "is a device that receives signals transmitted by media facilitator 14. Current examples include television sets ... radios, and stereo tuners." *Id.* at col. 3, lines 17-18.

Further, Chen does not teach establishing a two-way connection between the media content originator 12 and a consumer device, much less doing so in response to a connection

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request. Chen discloses communication between a consumer 12 and processing station 22, as well as between processing station 22 and media content originator 12. See Chen, Fig. 1 and col. 4, lines 18-38. In addition, Chen discloses that interaction between the consumer and the media content originator is through the processing station 22. However, Chen does not disclose establishing a connection between a consumer device and the media content originator that is not through the processing station. Nor does it disclose establishing a two-way connection between the consumer device and the media content originator, much less doing so in response to a connection request.

As discussed above, although Yuen discloses two-way interactions, it does not describe sending any requests to establish two-way communication or receiving a response containing connection information. Further, Yuen does not provide any indication that it would be desirable to implement a request system for establishing two-way communication between the information provider and the pager transmitter/receiver, and it is unclear how this would even be accomplished in the system of Yuen, either alone or in combination with Chen.

In contrast to Chen and Yuen, independent claim 2 as amended recites a call server that can perform steps of "receiving from a mobile device a first request to establish a two-way connection between a broadcast program and the mobile device, [and] establishing the requested two-way wireless connection" Similarly, independent claims 16 and 24 recite a mobile device that can perform steps of, or a computer-readable medium storing computer-readable instructions to cause a device to perform steps of "sending a request to establish a two-way connection between the device associated with the broadcast program and the mobile device ... and ... when the request is accepted, establishing the two-way connection" Independent claims 33 and 45 include similar subject matter for establishing a connection as claims 2, 16 and 24. As discussed above, this subject matter is not taught or suggested by Chen. Yuen does not overcome these deficiencies of Chen. Accordingly, Applicants respectfully submit that claims 2, 16, 24, 33 and 45, as well as claims 3-15, 17-23, 25-32, 34-44 and 46-60 depending therefrom, are allowable over Chen in view of Yuen.

In addition, with respect to claims 2, 5, 16-17, 24-25 and 51, the Office Action correctly states, "Chen does not explicitly mention the steps of sending a connection request with

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additional information to the device associated with the broadcast program and receiving a connection response from the device associated with the broadcast program, and the connection between the mobile device and the device associated with the broadcast program is a two-way wireless connection." Office Action, page 3. The Office Action subsequently only relies on Yuen to address the identified "two-way wireless connection" deficiency of Chen with respect to these claims. However, to overcome these deficiencies of Chen that are conceded in the Office Action the, the Office Action argues that because "Chen discloses the hand-shaking process between the call server and the device associated with the broadcast program, therefore it would be obvious to establish [these] steps."

Such a position is unsupportable, at least because Chen does not disclose the hand-shaking process suggested in the Office Action. The Office Action points to figs. 1-2 and col. 4, lines 24-29 for support that Chen discloses "hand-shaking with a device 12, 14 associated with a broadcast program." However, in this section Chen describes a process of order fulfillment in which processing station 22 either sends a product or information directly to the consumer or communicates an order to media content originator 12. (See Chen, col. 4, lines 24-27). Other than identifying communication of an order to the media content originator, Chen is silent on the type of communication between processing station 22 and media content originator 12 or any handshaking between the two.

Further, assuming *arguendo* that Chen does disclose the suggested hand-shaking process, such a teaching does not disclose the recited subject matter of claims 2, 5, 16-17, 24-25 and 51 of sending and/or receiving a request to establish a two-way connection between a broadcast program and a device. As discussed above, Chen does not disclose establishing a connection between a consumer device and the media content originator that is not through the processing station. Nor does it disclose establishing a two-way connection between the consumer device and the media content originator. As such, regardless of whether Chen teaches a hand-shaking process, it does not teach or suggest the recited subject matter of claims 2, 5, 16-17, 24-25 and 51 of sending and/or receiving a request to establish a two-way connection between a broadcast program and a device. Accordingly, Applicants respectfully submit that claims 2, 5, 16-17, 24-25 and 51 are allowable over the prior art of record.

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In addition, claims 36-44 and 48-50 are allowable for the further reason that neither Chen nor Yuen disclose or suggest the additional information in the request to establish a two-way connection as recited in these claims. The Office Action points to col. 5, lines 1-15 of Chen and argues that Chen discloses additional information sent from a consumer transmitter that may include a summary of an intended topic or location information. However, this portion of Chen teaches user entry of data specifying the broadcast information (e.g., radio station call letters) or account information. As such, Chen does not teach or suggest the additional information recited in these claims that is part of the request to establish a two-way connection, and Yuen does not overcome the deficiencies of Chen. For this additional reason, Applicants respectfully submit that claims 36-44 and 48-50 are allowable over the prior art of record.

Further, claims 6 and 54 are allowable for the further reason that neither Chen nor Yuen disclose or suggest the defined delay time recited in these claims. The Office Action suggests that delay times are inherent. However, the defined delay time, and a delay time defined by the broadcast program, as recited in these claims is not inherent. As described in paragraph 26 of the specification, defined delay times can provide advantages, such as providing the user with an option for indicating when to submit their request to a show or for providing a game show host control over the time to call participants. For this additional reason, Applicants respectfully submit that claims 6 and 54 are allowable over the prior art of record.

As to claim 53, in addition to the arguments set forth above, the Office Action states, "[t]he step of exiting the connection is a common sense step." The Examiner appears to take the position that it is common knowledge in the art but no references are cited to support this contention. It is respectfully submitted that it is not common knowledge in the art for a call server to exit a connection between a device and a broadcast program. A connection between a device and a broadcast program would typically be exited by either the device or the broadcast program rather than the call server. This is further demonstrated by the fact that neither of the cited prior art references teaches or suggests what the Examiner asserts is common knowledge. It is requested that if the Patent Office maintains this position, that a reference be supplied to support the assertion that such is "common knowledge."

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Conclusion

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated:

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